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HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/200,743	11/30/98	BENNEKER	F 068540002-US

HOWREY & SIMON  
BOX 34  
1299 PENNSYLVANIA AVENUE NW  
WASHINGTON DC 20004-2402

HM12/1207

EXAMINER

CHANG, C

ART UNIT	PAPER NUMBER
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1612  
DATE MAILED:

6  
12/07/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/200,743

Applicant(s)

Bennerker et al.

Examiner

Celia Chang

Group Art Unit

1612



☒ Responsive to communication(s) filed on Nov 4, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9, 11, 15, 17, 20-22, and 24-29 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-9, 11, 15, 17, 20-22, and 24-29 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. A preliminary amendment filed in Paper No. 4, dated Nov. 4, 1999 have been entered.

Claims 10, 12-14, 16, 18, 19, and 23 have been canceled. Claims 1-9, 11, 15, 17, 20-22, 24-29 are pending.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9, 11, 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen US 3,912,743 (1449) in view of Berge et al. J. Pharm. Sci.

Christensen et al. '743 disclosed the claimed pharmaceutically acceptable addition salts of the same compounds, their compositions and their use for treating depression. The difference between the Christensen et al. '743 and the instant claims is that the specific pharmaceutically addition salt, i.e. sulfonate, was not exemplified. Berge et al. taught that the specific sulfates are conventional pharmaceutical addition salts and FDA approve (see p.2 table anion, line 8 line mesylate, line 11 methysulfate). Therefore, it is prima facie obvious to choose an alternative conventional addition salt for the exemplified salts of Christensen '743 and with expectation of similar therapeutical effectiveness.

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This rationale is further supported by the article of Krage et al. US 5,955,475. Krage et al. '475 although is not prior art, supplied evidence that the conventional mesylate and methylsulfate are of choice for similar compound as the one proviso out in claim 1 (see col. 5-6 paroxetine and col. 6, line 26 sulfonic acids as pharmaceutical addition salts). The purity or solubility are not further limitation of the prima facie obvious salts rather are the innate nature for the prima facie obvious products.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 15, 17, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stemp et al. EP 190,496 in view of Drejer et al. EP 266,574 or Christensen et al. '743 (all cited on 1449).

Stemp'496 disclosed the claimed process of making pharmaceutically acceptable acid addition salts of the claimed compounds from another acid addition salt (see description 36 and 37 p.51-52). The particular salts have been generically disclosed by Stemp '496 (see p.3), Drejer (p.3 lines 46-48) or Christensen (col. 1, lines 40-41) and are expected to react in similar manner as exemplified for the process. The specific base in the dependent claim is also generically disclosed and exemplified by the references (see Stemp p.24, two lines after D11,

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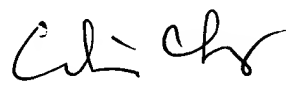
Drejer '574 p.10, example 4). There is nothing unobvious in picking some among many. In re Lemin 141 USPQ 814.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is (703) 308-4702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

CCC/Chang

Dec. 3, 1999

  
**CEILA CHANG**  
**PRIMARY EXAMINER**  
**GROUP 1200-1612**